

PATENT  
P56367REMARKS

Claims 1 through 22 remain pending in this application. Claims 1 and 21 are amended by this Amendment. Allowance of claim 20 and indication of the allowability of dependent claims 16 and 19, are noted with appreciation. Claim 21 is amended in minor particulars to assure antecedent basis.

Claim 21

Claim 21 was rejected under the second paragraph of 35 U.S.C. §112 as raising questions of antecedent basis. This is not a question of patentability, and claim 21 is readily understandable in its original form. Claim 21 is amended however, to conform to the ancient notion of antecedent basis. Withdrawal of the rejection and allowance of claim 21 is therefore proper.

Claims 1-12, 17, 18 and 22

Claims 1 through 12, 17, 18 and 20 stand rejected under 35 U.S.C. §103(a) as rendered obvious by Martin U.S. Patent No. 2,448,611. Applicant expressly traverses this rejection for the following reasons.

Martin '611 is a well prepared and carefully written U.S. patent. The express teachings of Martin '611 however, contradict the Examiner. Moreover, the Examiner has expressly ignored in paragraph 5 of Paper No. 17, the language of the rejected claims.

All of Applicant's rejected claims expressly define, *inter alia*, "magnetic members ... to permit contact therebetween" in combination with "a cover member covering said magnetic members ... to permit the page of the book to be readily received within said throat of the clip

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marker" (*see* claim 1, line 7-11). The Examiner has ignored and given no consideration to this feature of Applicant's claim 1. In contradistinction, Martin '611 expressly teaches a structure which, as illustrated in Figs. 2, 3, 6 and 7, as axial protrusions created by the combination of magnets 10 and covers 12 so that,

"To use the book mark, the ends of the mark having the magnets secured therein are *separated* and *placed* on opposite sides of the page to be marked. The magnets will be mutually attracted through the page and will therefore remain in position until removed."

This distinction is faithfully reflected in each of claims 1-4 of Martin '611, that define the book mark of Martin '611 as having the magnets "attracted when *placed* in alignment on opposite sides of the page to be marked. The exaggeration of the protrusion of magnets 10 caused by covering those magnets with the ends 12 in Martin '611 requires that the magnets be "*separated* and *placed* on opposite sides of the page," and prevents the provision of the structure defined by Applicant's claim 1 with "contact therebetween [the magnetic members] in combination with the "cover member ... to permit the page of the book to be *readily received* within said throat of the clip marker." Instead, Martin '611 requires a two step process of use to compensate for the exaggerated axial protrusions of his covered magnets, and thereby compensate for the obstruction to insertion of a page caused by the exaggerated protrusion of those covered magnets. The Examiner's attention is invited to page 8 of Applicant's originally filed specification, where Applicant describes the advantages provided by the interaction of the quoted features from the rejected claims as advantageously facilitating "the page sliding (6) and prevents the impingement

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between the edge (6') of the page and the permanent edges (8) of the magnetic means (3)(4), as it can be observed in Figs. 3, 3A and 5."

As discussed above regarding claim 1, and as expressly recognized by the Examiner on page 4 of the Examiner's comment, Martin '611 "does not disclose a clip portion overlapping a base portion ... and wherein the base portion or clip portion has a greater length than the other."

*not stated in claims*  
*not stated in claims*  
*do show*  
These distinctions may not be ignored in determining obviousness *vel non*. Applicant's combination advantageously contributes to the ease of insertion of the page, and unlike Martin '611, serves advantageously "to permit the page of the book to be readily received within said throat of the clip marker" while the "magnetic members [are] aligned with respect to one another and mounted to the base portion and said clip portion to permit contact therebetween" as defined by these rejected claims. The difference in Applicant's length between the clip portion and base portion providing Applicant's "overlapping" enables the extension, or non-overlapping terminal and of the clip portion to receive and guide the edge of the page between the contacting magnetic members. This feature is wholly absent, as the Examiner might be able to appreciate by again reviewing the express teachings of Martin '611, from a structure where the terminal ends are of equal length.

*not stated in claims*  
At about the time that Applicant's Paper No. 23 was issued, and possibly after the examiner prepared Paper No. 24, the Federal Circuit's decision in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002), has become available. Lee therefore respectfully requests the examiner to reconsider the issue of combination of references in the light of the Federal Circuit's very recent decision in the *Lee* case, *supra*.

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In that case, the Federal Circuit emphasized the need for specificity in documentation relied upon for a teaching, suggestion, or motivation to combine two or more references for purposes of § 103. Generalities will not do. Thus the Federal Circuit said (277 F.3d at 1343, citations omitted):

"The factual inquiry whether to combine references must be thorough and searching." It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [Collecting cases.] The need for specificity pervades this authority."

The Federal Circuit then rejected the PTO statement of motivation to combine, because it was too general and thus inadequate; also it used the advantages taught in the specification to justify making the combination of references. The court said (*id.* at 1343-44):

"[N]either the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."

The present rejection is very much like that condemned in the above-cited *Lee* case. First, Paper No. 24 concedes that as to the rejected claims, Martin '611 fails to disclose

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Applicant's "clip portion overlapping a base portion", but neglects to give any weight to this distinction. This neglect is impermissible in application of §103 obviousness determinations.

Paper No. 24 continues however, to assert that it would be an obvious matter of design choice to make different portions of the clip whatever portion of shape was desired, and cites *In re Dailey et al.*, 149 USPQ 47 (CCPA 1966). The Examiner ignores this express teaching of *Dailey* however, which was premised upon the simple fact that "appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations of person of ordinary skill in the art would find it obvious for the purpose of providing mating surfaces in the collapsed container of Matzen." *Dailey* @50. This is not the situation here, where Applicant has provided a difference in structure that, in combination with other features of claim 1, enable insertion of a page of a book while the clip and base portions of the bookmark are engaged. *Martin* '611 not only ignores this feature, but is unable to provide the resulting advantage and simplification in operation of his bookmark. The Examiner has no reason for ignoring these distinctions in structure and the differences in the resulting advantages such as ease of insertion of Applicant's bookmark.

Yet the Federal Circuit in *Lee* held that the determination of obviousness "could not be resolved on subjective belief and unknown authority." Also, it said (*id.* at 1344), "common knowledge and common sense" are not sufficient to support making an obvious rejection by combining references. Rather, substantial evidence documented in the record are essential. See also *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability" PTO "must point to concrete evidence in the record" and

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"cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense"). This alone would require withdrawal of the rejection.

The Examiner's reasoning is just the sort of bootstrapping that the Federal Circuit forbade in *Lee*. The rejection takes the advantages of the instant invention as taught in its specification, and uses them as supposed support for making the combination of references. But *Lee* says you cannot use that which the inventor taught against its teacher. The Examiner has to supply the justification for modifying the references *before* combining them to develop the motivation or suggestion; you cannot operate in the reverse direction.

Thus the statement of Paper No. 24 that "it would have been an obvious matter of design choice to make different portions of the clip whatever form of shape was desired or expedient" follows a chain of impermissible speculations and bootstrap use of the instant specification's teachings as the basis for combining the references, instead of finding an independent justification to combine the references before proceeding to combine their teachings.

It is therefore respectfully submitted that the instant rejection should be withdrawn in the light of the Federal Circuit's recent *Lee* decision.

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) for alleged unpatentability over Martin '611 as modified by Johnson '777 while claim 15 is rejected under 35 U.S.C. §103 as rendered obvious over a proposed combination of Martin '611 and Schwartz '043. As noted in the foregoing paragraphs, Martin '611 lacks the interaction and combination of elements defined by parent claim 1. In short, Martin '611 fails to provide a *prima facie* showing of obviousness.

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Moreover, these rejections because supplementation of the primary reference with these secondary references fails to satisfy the foregoing omission in the primary reference. Accordingly, withdrawal of these rejections and allowance of these claims are required.


Entry of the foregoing amendments under 37 C.F.R. §1.116(b) is requested, and is proper, because the foregoing amendment of allowable claim 21 simply changes the articles "said" to conform with ancient notions of antecedent basis, raise no issues and require no further searches and consideration.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

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A fee of \$55.00 for a *Small Entity* is incurred by the filing of a Petition for a one-month extension of time. Applicant's check drawn to the order of Commissioner accompanies this Amendment After Final. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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P56367MARKED-UP VERSION OF AMENDMENTSIN THE CLAIMS

Please amend claims 1 and 21, as follows:

1           1. (Amended) A magnetic clip marker for use in engaging and marking a page of a book,  
2           the clip marker including in combination:

3                   a pair of wall members aligned and joined together at a throat, with said pair of  
4           wall members comprised of a base portion and a clip portion overlapping said base portion to  
5           [define a throat therebetween and structurally arranged to] receive a page of a book between said  
6           base and said clip portions;

7                   magnetic members aligned with respect to one another and mounted to the base  
8           portion and said clip portion to permit contact therebetween; and

9                   a cover member covering said magnetic members on said overlapping base  
10          portion and said clip portion to permit the page of the book to be readily received within said  
11          throat of the clip marker.

1           21. (Amended) A magnetic clip marker for use in engaging and marking a page of a  
2           book, the clip marker including in combination:

3                   a plurality of discrete magnetic members each exhibiting a thickness;

4                   a pair of wall members of unequal length aligned and joined together at a throat to form  
5           an integral monolithic structure exhibiting a normally closed orientation, with said wall members

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6 comprised of a base portion adjacent [said] to terminal ends of said wall members and a clip  
7 portion overlapping said base portion and extending to said throat, said wall members being  
8 oriented to receive insertion of a page of a book between said base portion and said clip portion  
9 until an edge of the page engages said throat, said wall members bearing said magnetic members  
10 mounted [on] between said wall members, in aligned facing opposition to permit contact  
11 between said magnetic members; and

12 a cover member disposed along [said] an interior surface of one of said pair of wall  
13 members to form a continuous layer extending from a first of said [distal] terminal ends, around  
14 said throat and to a second of said [distal] terminal ends while covering and separating said  
15 magnetic members and forming a continuously gradual structural transition between a difference  
16 in separation between said opposite wall members and between said magnetic members  
17 attributable to said thickness.